

REMARKS

Applicant respectfully requests reconsideration of the claims in view of the present remarks.

Withdrawn Rejections

The Applicant notes, with appreciation, the withdrawal of the rejections under 35 U.S.C. § 112 and 102.

Response to rejections

The several rejections are treated in the order set forth in the Office action.

Rejections Under 35 U.S.C. § 101

Claims 1 and 49-79 stand rejected under 35 U.S.C. § 101 as directed to nonstatutory subject matter. The rejection is respectfully traversed.

The inventions of the rejected claims are methods for requesting, generating, using, and comparing various authentication codes to test and verify the identity of parties to an electronic authorization for a financial transfer. It is evident from the disclosure as a whole and express recitations in, for example, the preamble and body of claims 1 and 21 that the claimed methods are implemented in the context of an array of computers which perform the specified generating, transforming, and (in some instances) communicating steps of the methods, and that the methods are dependent on the provision of information (data) by both the transferor and the transferee.

For example, claim 1 describes an "input device" for receiving information from a transferor and a "processing means" as receiving a money transfer request. The specification describes the use of an input device in connection with Figure 9, clearly indicating a computer. Moreover, the use of "means plus function" language in claim 1 invokes 35 U.S.C. § 112, sixth paragraph. *See* MPEP § 2181. This should be interpreted as referring to embodiments disclosed in the specification and equivalents thereof for the processing means. *See id.* As previously indicated, the description clearly describes a series of steps to be performed by a computer. *See, e.g.,* page 9, line 27; page 10, line 4; page 12, line 14; page 13, line 8; Figures 1-5. Relatedly,

claim 21 similarly utilizes means plus function language, similarly invoking 35 U.S.C. § 112, sixth paragraph.

Further, the claimed methods involve the communication and transformation of data as part of a process for requesting and effecting an actual transfer of monies. Thus, it is respectfully submitted that the claims are directed to actual processes that serve useful and beneficial purposes, and not merely abstract ideas. Because performance of the claimed methods is a "practical application" of data processing algorithms that yields "a useful, concrete and tangible result," the claims are directed to patent-eligible subject matter under § 101.

Applicant accordingly requests that the examiner withdraw the rejection.

Rejections Under 35 U.S.C. § 103(a)

Claims 1, 21, 49-53, 59-87 and 89-94 were rejected as obvious over U.S. Patent No. 5,650,604 (*Marcous*). This rejection is respectfully traversed.

As indicated previously, the present invention is designed to facilitate a plurality of transactions involving a particular transferor or transferee. It does so by creating and associating a Personal Identifier Code ("PIC," i.e., the "first identifier code") with the transferor or transferee and storing that code in a database. When the code is created, it is communicated to the party it is associated with independent from transferor's communication with the input device. Thus, when a transferor initiates a transaction, a transaction-specific security code is generated using information that is not provided to or processed at the input device. The present invention therefore provides security against interception of the first identifier code or the information used to generate it between the input device and the processing means. Additionally, the party-specific code is associated with the transferor or transferee and retained in a database, thus facilitating future transactions.

With respect to claim 1, the Office has specifically indicated that "*Marcous* does not explicitly disclose where if a first identifier code is associated with the transferor or transferee in a database of transferors or transferees and associated first identifier codes, the code is retrieved from the database, or if no first identifier code is associated with the transferor or transferee in a database of transferors or transferees and associated first identifier codes, a new first identifier code is allocated in response to receiving the money transfer request and associated with the

transferor or transferee.” Page 6 of the present Office action. With respect to claim 21, the Office has specifically indicated that “*Marcous* does not explicitly disclose means for allocating a first identifier code to a transferor or transferee, and a database of transferors or transferees and associated first identifier codes.” Pages 7-8 of the present Office action. However, the Office indicates that these steps are “commonly used.” In this respect, the Office provides examples of a “registered” user of a database that is provided a pin number for use in accessing the database. The Office states that this pin is associated with the user and, after it is provided to the user, the same pin is verified for future access to the (internet) database. Based on these database examples, the Office indicates that it would have been obvious to one of skill in the art to modify *Marcous* to “include identification verification means to verify the user if he/she is previously registered or not and add the user to the database if he/she is a new user to further access to the system.”

In reply, the Applicant respectfully notes that the database examples presented by the Office bears no specific relation to a money transfer request. As such, there is no need or suggestion to transfer the pin number of this internet database example from a “registered” user to a third party. In contrast, transfer of such information is often prohibited under terms of the agreement permitting access to the (internet) database. Moreover, the transferee of the claims utilizes the identifier code to obtain funds, rather than to gain access to a database. Further, there is no teaching or suggestion that the pin number of these database examples is sent to the “registered” user of the database independently of this user’s communication or registration with the database (see especially claims 78 & 94). This type of independent communication of the pin number conflicts with the purpose of *Marcous* to provide a means of transferring funds “around the clock.” See *Marcous* at col. 3, lines 43-45.

As indicated previously, *Marcous* is directed to methods of authenticating individual transactions. As such, the methods disclosed in the reference involve generating transaction-specific security codes or PINs. These codes are generated as a function of the amount of funds transferred and an arbitrary number provided by the transferor, such as a telephone number or social security number. See *Marcous* at col. 5, lines 22-33. The only database described in the reference contains information associating particular transactions with transaction-specific codes.

Accordingly, taken together, *Marcous* and the Office's database examples fail to teach all of the limitations of claims 1, 21, 49-53, 59-87 and 89-94.

Assuming *arguendo* that the modification of *Marcous*, in view of the Office's database examples, taught or suggested the subject matter of claims 1, 21, 49-53, 59-87 and 89-94, this modification is improper as no suggestion or motivation to modify *Marcous* has been elucidated.

As the Office is aware, in contrast to an anticipating reference, the teachings of a reference utilized as the basis for an obviousness rejection must be modified or combined with another reference to serve its intended purpose. When a single reference is utilized to render a claim obvious, there must be a showing of a suggestion or motivation to modify the teachings of that reference to the claimed invention in order to support the obviousness conclusion. See *B.F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996). The sufficiency of this "showing" is the same, regardless of whether the reference requires modification or combination with another reference to render the claims obvious. See generally *Sibia Neurosciences, Inc. v. Cadus Pharma. Corp.*, 225 F.3d 1349, 1356, 55 USPQ2d 1927, 1931 (Fed. Cir. 2000) (relying on "motivation to combine" related case law in support of a "motivation to modify" determination). This showing may be derived from the reference itself, from the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996). However, as this requirement is important to ensure that the insidious effect of hindsight is avoided, this showing must be "clear and particular." See *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (emphasis added) ("Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" *Id.*).

In the present case, the Office has not clearly and particularly pointed out the suggestion or motivation to modify the teachings of *Marcous* such that they render the present claims obvious. The Office has pointed to unrelated database subscription examples and summarily concluded that one of skill in the art would have been motivated to modify *Marcous* to incorporate the use of a subscriber-specific pin.

Assuming *arguendo* that the proposed modification teaches or suggests all of the limitations of the present claims (which, as set forth above, it does not), one of skill would not

have been motivated to modify *Marcous* to arrive at the present claims. In particular, the inclusion of a limitation to the *Marcous* system requiring the generation and/or use of a transferor or transferee associated code introduces an unnecessary additional level of complexity. The "security" and "convenience" issues of *Marcous* are addressed via the use of variables comprising (1) the amount of money to be transferred, (2) a separate security code and (3) a system generated pin comprising a function of the first two variables. Requiring a fourth variable comprising a transferor or transferee associated code would provide no additional benefit to the *Marcous* system; it would simply increase the burden on the transferor and the transferee necessary to obtain a successful transfer.

Although the Office has not so stated, if the Office proposes the removal of one of the current *Marcous* limitations and replacement with a transferor or transferee associated code, there is no indication of which of the *Marcous* variables should be removed/replaced. The Applicant respectfully asserts that this choice would not be obvious to one of skill in the art, even in light of the database examples set forth by the Office. Any proposed improvements to the *Marcous* system are evident only in light of the present disclosure.

The Office further describes deficiencies of *Marcous* with regard to claims 49-53, 59-87 and 89-94, that are not necessary to address herein as they each depend, directly or indirectly from claims 1 or 21. As indicated above, the claimed modification fails to render the broader independent claims obvious, and therefore fails to render the dependent claims obvious as well.

Based on the foregoing, the Applicant respectfully requests reconsideration and withdrawal of the rejection.

35 U.S.C. § 103 Rejection Over *Marcous* In View Of *Tedesco*

Claims 54-58 stand rejected as obvious over *Marcous* in view of U.S. Patent No. 6,282,523 (*Tedesco*). The rejection is respectfully traversed.

The Applicant notes that *Tedesco* was issued on 28 August 2001 and was not subject to early publication. Moreover, the Applicant notes that the filing date of *Tedesco* is 28 June 1998. Although the *Tedesco* description incorporates a cross-reference to a "related" co-pending application, filed 5 March 1997, no apparent priority is claimed from this application. As such, *Tedesco* was not available until after the effective filing date of the present application, 1

December 1997, and is not properly citeable against the present claims. As such, withdrawal of this rejection is respectfully requested.

Notwithstanding the foregoing, the methods of *Tedesco*, like those of *Marcous*, involve event-specific codes. See *Tedesco* at the abstract. Additionally, the prior art invention is directed to solving a different problem than the present invention, namely, ensuring that funds are available to pay checks in the context of a transaction between the party presenting the checks and a bank. The examiner has identified no teaching in the reference that would lead one of ordinary skill in the art to modify the method of *Marcous* to employ the distinguishing features of the invention. In particular, *Tedesco* does not teach or suggest that one character of the first code comprises a function of a character of the second code.

The Office merely concludes that the aspects of these claims not taught or suggested by *Marcous* would have been obvious and that these aspects were taught by *Tedesco*. Only in selected embodiments that are clearly distinguishable from the present claims does *Marcous* propose the use of an account number. Moreover, *Marcous* explicitly indicates that the data verification scheme comprises the (1) the amount of money to be transferred, (2) a separate security code and (3) a system generated pin comprising a function of the first two variables. Accordingly, it is not understood why one would be motivated to look beyond *Marcous* for the limitations discussed by the Office.

In this regard, the Office has not clearly and particularly pointed out the suggestion or motivation to combine the teachings of *Marcous* with *Tedesco*. As indicated above, such motivation is required in order to present a *prima facie* case of obviousness. As this combination appears to be based on the blueprint of the present application, the Office has not met this burden.

Accordingly, the invention of claims 54-58 is not obvious, and withdrawal of the rejection is requested.

35 U.S.C. § 103 Rejection Over *Marcous* In View Of *Atalla*

Claim 88 stands rejected as obvious over *Marcous* in view of U.S. Patent No. 5,319,710 (*Atalla*). Applicant traverses the rejection.

Atalla is directed to methods of encrypting messages by generating a code combining a message-specific function and a PIN code. See *Atalla* at the abstract. The code is generated "in response to a user's message and [PIN]." *Atalla* at claim 1. Thus, the system and method of *Atalla* employ a PIN provided at the input device by the user at the time the transaction is initiated, in the conventional manner.

The present invention, as discussed above, employs a user-specific identifier code that is not entered into the input device by the user, but is instead generated anew or obtained from a separate database of users and associated identifier codes. Neither *Atalla* nor *Marcous* teaches or suggests such an arrangement, and neither teaches why it would be desirable to have a PIN not provided at the input device.

In this regard, the Office has not clearly and particularly pointed out the suggestion or motivation to combine the teachings of *Marcous* with *Atalla*. As indicated above, such motivation is required in order to present a *prima facie* case of obviousness. As this combination appears to be based on the blueprint of the present application, the Office has not met this burden.

Accordingly, the claims are patentable over the cited art. Withdrawal of the rejection is requested.

Conclusion

If any questions or issues remain, the examiner is invited to contact the undersigned attorney to resolve them.

Respectfully submitted,



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